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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,835	10/19/2001	Alex S. Taylor	110914	7065
27074	7590	12/06/2004	EXAMINER	
OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			RIES, LAURIE ANNE	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/981,835

**Applicant(s)**

TAYLOR ET AL.

**Examiner**

Laurie Ries

**Art Unit**

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-17 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/31/02.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to communications: amendment, filed 10/26/2004, to the original application filed 10/19/2001.

#### ***Response to Arguments***

Applicant's arguments, see amendment, filed 10/26/2004, with respect to the rejection of claims 1, 2, 9-11, and 13 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Applicant's arguments, see amendment, filed 10/26/2004, with respect to the rejection of claims 3-8, 12, and 14-17 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103(a).

#### ***Claim Rejections - 35 USC § 103***

Claims 1-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovvchinsky.

As per claims 1-2 and 9-11, Price discloses a system and method of processing a target document including a search device for searching the target document to identify whether any words of interest are present in the target document (See Price, Page 34, Column 1, paragraph 3) and an annotation device for annotating the words located in the target document (See Price, Page 34, Figure 5). Price does not disclose expressly detecting one or more annotated regions in a source document, and inputting and storing a number of words of interest from the detected annotated region.

Golovchinsky discloses retaining the selection of an instance of a word on a page (See Golovchinsky, Page 22, Column 1, paragraphs 1-2). Golovchinsky also discloses that the selected word is annotated by the user (See Golovchinsky, Pages 21-22, Section 4.3.1). Price and Golovchinsky are analogous art because they are from the same field of endeavor of using freeform ink annotations as queries. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the retention of the selection of annotated words on a page of Golovchinsky with the system and method of processing a target document of Price. The motivation for doing so would have been to accumulate information about how often users select each word (See Golovchinsky, Page 22, Column 1, paragraph 1). Therefore, it would have been obvious to combine Golovchinsky with Price for the benefit of determining how often users select each word to obtain the invention as specified in claims 1-2 and 9-11.

As per claims 3 and 12, Price and Golovchinsky disclose the limitations of claims 2 and 10 as described above. Price also discloses including a capture device for

optically capturing a digital image of a physical source document (See Price, Page 35, Column 2, paragraph 6).

As per claims 4 and 13, Price and Golovchinsky disclose the limitations of claims 3 and 11 as described above. Price also discloses detecting annotations in a captured image of the source document (See Price, Page 34, Column 1, paragraphs 2-3).

As per claims 5 and 14, Price and Golovchinsky disclose the limitations of claims 4 and 13 as described above. Price also discloses detecting a type of annotation (See Price, Page 34, Column 1, paragraph 2).

As per claims 6 and 15, Price and Golovchinsky disclose the limitations of claims 5 and 14 as described above. Price also discloses that the type of annotation detected includes one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring (See Price, Page 34, Column 1, paragraph 2).

As per claims 7 and 16, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price also discloses optically capturing a digital image of a physical target document to be annotated (See Price, Page 35, Column 2, paragraph 6).

Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price in view of Golovchinsky as applied to claims 1 and 9 above, and further in view of Evans (U.S. Patent 6,363,179 B1).

As per claims 8 and 17, Price and Golovchinsky disclose the limitations of claims 1 and 9 as described above. Price and Golovchinsky do not disclose expressly that the annotating includes annotating one or more words in the target document using the

same type of annotation as used in a source document from which the stored words are derived. Evans discloses highlighting the text in a second document that corresponds to the highlighted text in a first document. (See Evans, Column 2, lines 1-14). Price, Golovchinsky and Evans are analogous art because they are from the same field of endeavor of processing digital documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the highlighting annotations of Evans with the source and target documents of Price and Golovchinsky. The motivation for doing so would have been to display in a visually distinct manner a region of the second document image that corresponds to the matching word in the first document so that the user may more easily identify a matched search term. (See Evans, Column 2, lines 15-18). Therefore, it would have been obvious to combine Evans with Price and Golovchinsky for the benefit of easily identifying matching terms in a first and second document to obtain the invention as specified in claims 8 and 17.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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- Britton (U.S. Publication 2003/0018668 A1) discloses a method and system for improving the transcoding operations which are performed on structured documents through the use of annotations.


- Schilit (U.S. Patent 6,279,014 B1) discloses a method and system for organizing documents based upon annotations in context.
- Golovchinsky (U.S. Publication 2004/0078757 A1) discloses a system, apparatus and article of manufacture for detecting a reader's interest in a particular external document through their markings and annotations.
- Krause (U.S. Patent 6,154,757) discloses an electronic text reading environment enhancement method and apparatus.
- Van Hoff (U.S. Patent 5,822,539) discloses a system for adding requested document cross references to a document by annotation proxy.
- Bruggemann-Klein discloses a method for searching bibliographic databases using annotated content-based relations.
- Ginsburg discloses a knowledge management support system for document collections.
- DeVries (U.S. Patent 6,332,144 B1) discloses a technique for annotating media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER